have been amended and it is believed that adequate antecedent basis is now provided. Accordingly, applicants respectfully request withdrawal of the § 112, second paragraph rejections.

Claims 1-5, 9-10, 15-20, 24-25, and 28-33 were provisionally rejected under the judicially created doctrine of double patenting over claims 6-10, 12-16, and 18 of co-pending Application No. 09/106,659. A terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) is provided in conjunction with this amendment. Such is proper as Application No. 09/106,659 is commonly owned with the present application. Withdrawal of the non-statutory double patenting rejection accordingly respectfully is requested.

Claims 1, 11, 15, 28 and 30-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,830,063 to Byrne. As amended, however, independent claims 1 and 15 recite providing a group participation game in which a plurality of indicia are generated and having an outcome of the game be based on matching a subset of indicia common to the group. Both independent claims also recite that none of the game entrants are allowed to select the subset of indicia. Additionally, independent claim 15 further includes the limitation that the group participation game and the individual participation game are independent of one another.

In contrast, Byrne discloses a "collateral gambling game" which is used in combination with a principal game. Specifically, Byrne only teaches a secondary game whose outcome is based upon one of the players enrolled in the secondary game achieving a winning result in his or her individual game. "That is any player playing the bank of interlinked machines who wins the main Jackpot (standard game) automatically activates the collateral Jackpot and all players who are entered into the collateral game will receive a share of the collateral Jackpot." (Col. 14, Lines 24-31). Thus, Byrne does not teach the limitation of determining the outcome of a group participation game based on matching a common subset of indicia for the entire group. Moreover,

Byrne fails to teach a secondary game which is independent of the individual participation game or a group game in which none of the game entrants are allowed to select the subset of indicia.

It is applicants' position that Byrne fails to teach all the limitations of claims 1 and 15. Accordingly, applicants respectfully request the withdrawal of the § 102(e) rejection with respect to these claims. Additionally, applicants request the withdrawal of the § 102(e) rejection with respect to dependent claims 11, 28 and 30-31.

Claims 12-14, 26-27 and 33-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne. Specifically, with regard to claims 12-13, 26-27 and 24, the Office Action states that it would have been obvious to one skilled in the art at the time of the invention to include a fixed wager feature as a matter of design choice despite the lack of such teaching in Byrne. Claims 12-13 and 26-27 depend from independent claims 1 and 15 respectively. Both claims 1 and 15 have been amended to include the limitation of a group participation game having an outcome based upon matching a common subset of indicia. As discussed above, Byrne fails to teach this limitation. Accordingly, because Byrne fails to teach the limitations of claims 12-13 and 26-27, applicants respectfully request withdrawal of the § 103(a) rejection with respect to these claims.

Regarding claims 14 and 33, the Office Action states that it would have been obvious to a person of ordinary skill in the art to modify Byrne to include disclosing the determination of the outcome of the group game before the outcome of the individual game, despite the lack of such teaching in Byrne. Applicants respectfully traverse this rejection. Both amended claim 14, which depends from amended claim 1, and amended claim 33 include the limitation of determining the outcome of the group game prior to determining the outcome of the individual game. Byrne, on the other hand, teaches away from such an order of events. As discussed above, Byrne teaches only a group game wherein the outcome is based upon one of the entrants in the group game achieving a

winning result in his or her individual game. Thus, determination of the outcome of the individual game necessarily must occur prior to determination of the outcome of the group game. The issue herein is one of determination rather than disclosure.

As Byrne fails to teach, and in fact teaches away from, the limitation of amended claims 14 and 33 which recite determining the outcome of the group participation game prior to determining the outcome of the individual game, applicants respectfully request withdrawal of the § 103(a) rejection with respect to these claims. As claims 34 and 35 depend from amended claim 33, withdrawal of the § 103(a) rejection respectfully is requested with regard to these claims as well.

Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of U.S. Patent No. 5,112,050 to Koza et al. Specifically, the Office Action states that it would have been obvious to one skilled in the art to combine Byrne, which lacks the teaching of a lottery game as the individual participation game, with Koza et al., which discloses a broadcast lottery game, to teach the invention of the present invention. Claim 32, however, is dependent on claim 15, which has been amended to include the limitation of a group participation game having an outcome based on matching a common subset of indicia. As discussed above, Byrne fails to teach this limitation. Similarly, Koza et al. discloses a broadcast lottery game in which each individual participant is given a set of numbers to match. Koza et al. also does not disclose the limitation of claim 15 reciting the matching of a subset of indicia common to the group entrants. Accordingly, because the combination of Byrne and Koza et al. fails to teach the limitations of claim 32, applicants respectfully request withdrawal of the § 103(a) rejection.

Claims 2-5, 9-10, 17-20, 24-25 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of U.S. Patent No. 5,393,057 to Marnell, II. Specifically, the Office Action states that Byrne lacks in disclosing the feature of randomly generating indicia in an array and

comparing the indicia with a predetermined combination of indicia. Accordingly, the Office Action combines Byrne with Marnell II which discloses a poker game feature as the principal game in a gaming machine.

Generally, Marnell II discloses a principal game in which a single user is given a plurality of randomly issued cards, which can be exchanged for different cards. As video poker is an inherently individual game requiring user participation, the game disclosed in Marnell II would be incompatible as the group game recited in the claims of the present application. In fact, the invention of the present application teaches away from the game taught in Marnell II by prohibiting the entrants from selecting or modifying the subset of game indicia. Claims 2-5, 9-10, 17-20, 24-25 and 29 are dependent on independent claims 1 and 15, respectively. Accordingly, Byrne in combination with Marnell II fails to teach the limitation of providing a group game having an outcome based on a single common play. Thus, applicants respectfully request withdrawal of the § 103(a) rejection with respect to the claims.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of U.S. Patent No. 5,772,509 to Weiss. Specifically, the Office Action states that while Byrne fails to disclose forming a group of all the winners of the individual participation game, it would be obvious to combine the teaching of Byrne with Weiss to teach this additional limitation. Claim 16 is dependent on claim 15, which has been amended to include the limitation of providing a group game which is independent of an individual participation game and in which the outcome for the group is determined by matching a common subset of indicia. In contrast, Weiss only teaches a secondary video game connected to a plurality of individual participation games in which the public is able to view the second individual game. Similar to Byrne, Weiss also fails to teach the

limitation of matching a common subset of game indicia. Accordingly, applicants respectfully request withdrawal of the § 103 rejection with respect to claim 16.

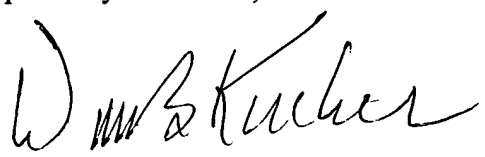
Claims 6-8 and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of Marnell II, further in view of U.S. Patent No. 5,833,537 to Barrie. Specifically, the Office Action states that while Byrne in combination with Marnell II, fails to disclose the features of a mechanical wheel gaming device or of multipliers on a slot machine wheel device, it would have been obvious to a person of ordinary skill in the art to combine Byrne and Marnell II with Barrie to teach these additional limitations. Claims 6-8 and 21-23, however, are dependent upon claims 1 and 15 respectively which have been amended to include the limitations of providing a group participation game in which a plurality of indicia are generated and having an outcome of the game be based upon matching a subset of indicia common to the group. Both amended claims also recite that none of the game entrants are allowed to select the subset of indicia. Additionally, independent claim 15 further includes the limitation that the group participation game and the individual participation game are independent of one another.

In contrast, Barrie only teaches an individual participation game which includes a mechanical wheel gaming device with multipliers on the slot machine wheel. Byrne, Marnell II and Barrie all fail to teach the limitation of matching a subset of game indicia which is common to a group of players. Accordingly, applicants respectfully request withdrawal of the § 103(a) rejection with respect to claims 6-8 and 21-23.

Claims 36-40 have been added. It is applicants' position that no new matter has been added and that there is sufficient disclosure within the present application to support the additional claims. Accordingly, applicants respectfully request the allowance of the new claims.

In view of the foregoing, it is submitted that the present application is in a condition for allowance and such allowance is respectfully requested. Should any unresolved issues remain, please feel free to contact the undersigned at the phone number listed below. The Commissioner is hereby authorized to charge any additional amount, to acquire or credit any overpayment, to account number 19-2112.

Respectfully submitted,



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